

REMARKS

In order to expedite issuance of the present application, claims 1-20 have been canceled without prejudice/disclaimer to the subject matter embodied thereby. New claims 21-40 have been added.

Claims 21 and 29 are independent and each embodies a step of forming a ferroelectric film which is selectively grown on an electrode. One exemplary embodiment of such a process is described on page 9, line 9 – page 10 of Applicants' specification corresponding to Figures 2A,2B of Applicants' drawings. The cited prior art appears to be completely silent as to forming a ferroelectric film which is *selectively grown* on an electrode in the claimed combinations defined in claims 21 and 29. Instead, Hasegawa discloses conventional deposition processes (e.g., spin coating, dipping, sputtering, MOCVD and laser ablation; *see* col. 8, lines 50-53).

Turning to Lee, powder of the ferroelectric material is placed in a furnace (1500 °C, 100 psi) for 20 hours to melt the powder (*see* col. 3, lines 24-34). Hasegawa would not be amenable to such a process. Indeed, substrate 110 of Hasegawa appears to be a silicon substrate in that it is disclosed as a semiconductor substrate with a LOCOS process being performed (*see* col. 8, lines 25-28). As readily recognizable, one of ordinary skill in the art would not look to anneal a silicon substrate at 1500 °C for 20 hours in a furnace.

This incompatibility between Hasegawa and the processing of Lee emphasizes the processing distinction between the present invention and Lee in that the present invention forms a ferroelectric film as part of a process for forming a *collective* structure (e.g., forming ferroelectric film on an electrode which itself was formed on a substrate); whereas Lee forms a ferroelectric wafer *per se* as an *individual* structure rather than forming the ferroelectric wafer on other structures, etc., so that the processing parameters of Lee do not affect other structures of a

combination (e.g., electrodes/substrate of a capacitor). In this regard, the processing parameters of Lee (i.e., 1500 °C for 20 hours) would not be incorporated into a process for forming a collective structure (e.g., capacitor of Hasegawa).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that neither Hasegawa nor Lee anticipate claims 21 and 29, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 21 and 29 because Hasegawa and Lee, alone or in combination, fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 21 and 29 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

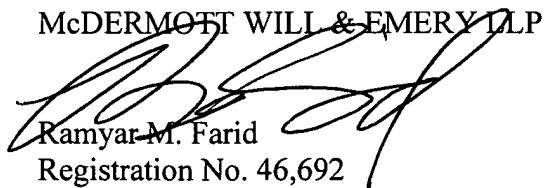
CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Ramyar M. Farid
Registration No. 46,692

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:MWE
Facsimile: 202.756.8087
Date: March 7, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**